

SUNESIS.2DV1C2

PATENT

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Applicant : Wells et al.
Appl. No. : 10/082,046
Filed : February 20, 2002
For : METHODS FOR RAPIDLY
IDENTIFYING SMALL
ORGANIC MOLECULE
LIGANDS FOR BINDING TO
BIOLOGICAL TARGET
MOLECULES

) Group Art Unit 1627

)

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September 24, 2002

(Date)

Ginger R. Dreger, Reg. No. 33,055

Examiner : J. D. Epperson

RESPONSE TO RESTRICTION REQUIREMENT

United States Patent and Trademark Office
P.O. Box 2327
Arlington, VA 22202

Dear Sir:

This is in response to the Office Action (Paper No. 3) mailed on August 13, 2002 in connection with the above-identified patent application, setting a one-month term. The present Response is accompanied by a request for a one-month extension of time.

The Office Action indicates claims 2-63 as pending in this application, identifies four separate and independent inventions (Groups I-IV) represented by these claims, and requests election of a single species from within each group of inventions.

When preparing the Office Action, the Examiner has apparently overlooked the instructions in the transmittal sheet accompanying the present application at the time of filing, which directed the cancellation of claims 2 through 39. In addition, a Preliminary Amendment dated February 20, 2002, filed concurrently with the present application, directed the cancellation of claim 1, and added new claims 40-63. Accordingly, only claims 40-63 are pending in the present application.

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Appl. No. : 10.082,046
Filed : February 20, 2002

As claims 40-63 have been indicated in the Office Action as a single invention, referred to as Group IV, the restriction requirement is moot.

In addition, applicants were requested to elect one species from within each of Subgroups 25-29 defined on pages 12 and 13 of the Office Action. Applicants were also requested, in each election requirement, to indicate which claims read only on the single disclosed species. It is believed that the latter requirement is improper. Under the procedure outlined in M.P.E.P. Section 803.02, after electing a single disclosed species for examination purposes, applicants are required to provide a listing of all claims readable on the elected species, including genus claims encompassing but not limited to the elected species. Such genus claims will initially be examined only to the extent that they read on the elected species. This requirement is correctly cited in section 15 of the Office Action. Accordingly, applicants will provide below a listing of all claims readable on the elected species.

Applicants hereby elect the following species:

Subgroup 25 (as a species of the -SH group): masked -SH; claims 40-63 are readable on this elected species, there is no claim that reads on the elected species only;

Subgroup 26 (as a species of the target protein): enzyme; claims 40-63 are readable on this elected species, there is no claim that reads on the elected species only;

Subgroup 28 (as a species of detecting the formation of the target protein-ligand conjugate and identifying the ligand present in the conjugate): mass spectroscopy; claims 40-51, and 59-60 read on this elected species, of which claims 49-51, and 60 read on the elected species only;

Subgroup 29 (as a species of method): the method of claim 40; claims 40-58 are readable on the elected species, all of which read on the elected species only.

Applicants were also requested to elect a species of ligand candidate from within Subgroup 27. In particular, applicants were requested to elect a ligand candidate "wherein a specific structure is set forth, which clearly shows all of the atoms and bonds that are necessary to define the ligand candidate." In addition, applicants were requested to "disclose the size of the ligand." The species of a non-peptide organic compound of less than 750 daltons, comprising a disulfide bond is hereby elected, with traverse. Claims 40-63 are readable on this elected species, of which claim 43 reads on the elected species only.

Applicants can only be required to elect from within individual species that are disclosed in the application. As the present application does not, and need not, disclose specific structures

Appl No. : 10.082,046
Filed : February 20, 2002

of ligand candidates, the requirement to elect one of such (undisclosed) structures has no legal foundation. Indeed, the only significant property of the ligand candidates for the purpose of the present invention is the ability to form a covalent bond, e.g. a disulfide bond with a reactive group on the target molecule. Accordingly, applicants have elected the species of a ligand candidate of less than 750 daltons, which carries a disulfide group (see, e.g. claim 43). It is believed that further specification of the species, as the Office Action appears to indicate, is not possible and not necessary.

The examination of the present application on the merits, and an early issuance of a Notice of Allowance are respectfully solicited.

Please charge any additional fees, including any fees for additional extension of time, or credit overpayment to Deposit Account No. 11-1410.

Respectfully submitted,

KNOBBE, MARTENS, OLSON & BEAR, LLP

Dated: Feb 24, 2002 By: _____

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RESTRICTION ELECTION FACSIMILE TRANSMISSION

DATE: September 24, 2002

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TO EXAMINER: J.D. Epperson

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